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09/226,107	01/07/1999	YASUNORI WATANABE	102491	1509

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 05/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/226,107

Applicant(s)

WATANABE ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 12-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment was received on 2/10/03, and has been entered and made of record. Currently, **claims 1-23** are pending.

### *Information Disclosure Statement*

2. The references listed in the Information Disclosure Statement submitted on 2/10/03 have been considered by the examiner (see attached PTO-1449).

### *Response to Arguments*

3. Applicant's arguments with respect to **claims 1 and 21** have been considered but are moot in view of the new ground(s) of rejection.
4. Upon review of the prior art previously cited in the Office action dated 9/9/02, the examiner notes that the reference of Tanoue *et al.* (U.S. Patent Number 5,884,117) can be interpreted as teaching the current amended independent claims. A full discussion of the reference appears below.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. **Claims 1-5, 7-11, and 21-23** are rejected under 35 U.S.C. 102(e) as being anticipated by Tanoue *et al.* (U.S. Patent Number 5,884,117, cited in the Office action dated 9/9/02).

Regarding **claim 1**, Tanoue discloses a multi-functional device (column 1, lines 8 through 15) comprising an outer casing having a front side, a rear side opposing the front side, and a lower side (printer body 1, see Figs. 1 and 2), a shaft supported on the outer casing (hinge 2a, column 8, lines 12 through 19), a recording section that records images on a recording medium (process cartridge 40, column 4, line 44 through column 5, line 9), and a reading section that reads images from a document (image reading unit 90, column 4, lines 24 through 37), with the reading section having a front edge substantially in coincidence with the front side of the outer casing, a back edge opposing the front edge, left and right walls, and a lower surface (see Fig. 1),

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the reading section being disposed above the shaft and pivotable about the shaft (column 8, lines 12 through 19, see Figs. 1 and 2), wherein when the reading section pivots away from the recording section such that the front edge moves forward and downward (see Fig. 2, arrow D), a space is provided above the recording section (large access section 1a, column 8, lines 16 through 19), and the recording section is exposed outside through the space (column 8, lines 20 through 25).

Regarding *claim 2*, Tanoue discloses the device discussed above in claim 1, and further teaches that the reading section is disposed closer to the front side of the outer casing than the recording section (see Fig. 1) and is pivotable toward the front side of the outer casing (see Figs. 1 and 2, arrow D).

Regarding *claim 3*, Tanoue discloses the device discussed above in claim 1, and further teaches that the shaft (hinge 2a, column 8, lines 12 through 19) is disposed adjacent to the recording section and disposed nearer the front side of the outer casing than the recording section (see Figs. 1 and 2).

Regarding *claim 4*, Tanoue discloses the device discussed above in claim 1, and further teaches of a control panel (board 98) having a front end substantially in coincidence with the front side of the outer casing, a rear end opposing the front end, and a lower surface (see Figs. 1 and 4), wherein the reading section is disposed on the lower surface of the control panel and pivotable together with the control panel, such that the front end of the control panel moves downward (see Fig. 2).

Regarding *claim 5*, Tanoue discloses the device discussed above in claim 4, and further teaches of a document holding section that extends from the rear end of the control panel for

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supporting documents to be conveyed to the reading section (document-feeding tray 91, column 9, lines 25 through 58), wherein the document holding section moves together with the reading section, and serves as a cover for covering the recording section when not moved open (see Figs. 1 and 2).

Regarding *claim 7*, Tanoue discloses the device discussed above in claim 1, and further teaches that the reading section is disposed adjacent to the recording section and covers at least a portion of the recording section (see Figs. 1 and 4).

Regarding *claim 8*, Tanoue discloses the device discussed above in claim 4, and further teaches of a document discharge tray pivotally and detachably mounted near the front edge of the reading section for receiving documents discharged from the reading section (face-up delivery tray 82, column 8, line 66 through column 9, line 5), wherein the document discharge tray is maintained at a predetermined angle with respect to a direction in which the documents are discharged when in use (see Figs. 1 and 6, and column 11, lines 29 through 32) and is pivotable in a direction opposite the pivoting direction of the reading section (via hinges 82a, 82b, and 82c, column 8, line 66 through column 9, line 5).

Regarding *claim 9*, Tanoue discloses the device discussed above in claim 8, and further teaches of a document discharge tray mounting portion on which the document discharge tray is mounted, wherein the document discharge tray is mounted on the document discharge tray mounting portion from upward (see Figs. 1, 2, and 4, column 8, line 6 through column 9, line 5).

Regarding *claim 10*, Tanoue discloses the device discussed above in claim 8, and further teaches of a recording paper discharge tray (delivery tray 22) having an underside, right side and a left side, with the recording paper discharge tray being provided on the front end of the outer

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casing for receiving recording paper discharged from the recording section (see Figs. 1 and 4), the recording paper discharge tray normally slanting upward and being displaced downward due to contact from the reading section when the reading section pivots away from the recording section (see Fig. 4).

Regarding **claim 11**, Tanoue discloses the device discussed above in claim 10, and further teaches of an urging member (abutting member 21), wherein the recording paper discharge tray is pivotally supported on the outer casing (see Fig. 2) and is supported by the urging member to slant upward (column 5, lines 48 through 67).

Regarding **claim 21**, Tanoue discloses a multi-functional device (column 1, lines 8 through 15) comprising an outer casing having a front side, a rear side opposing the front side, and a lower side (printer body 1, see Figs. 1 and 2), a shaft supported on the outer casing (hinge 2a, column 8, lines 12 through 19), a recording section that records images on a recording medium (process cartridge 40, column 4, line 44 through column 5, line 9), and a reading section that reads images from a document (image reading unit 90, column 4, lines 24 through 37), with the reading section having a front edge substantially in coincidence with the front side of the outer casing, a back edge opposing the front edge, left and right walls, and a lower surface (see Fig. 1), the reading section being disposed above the shaft and pivotable about the shaft (column 8, lines 12 through 19, see Figs. 1 and 2), in a manner that the front edge moves forward and downward so as to separate from the recording section (see Fig. 2, arrow D), whereby a space is provided above the recording section (large access section 1a, column 8, lines 16 through 25).

Regarding **claim 22**, Tanoue discloses a multi-functional device (column 1, lines 8 through 15) comprising an outer casing having a front side, a rear side opposing the front side,

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and a lower side (printer body 1, see Figs. 1 and 2), a shaft supported on the outer casing (hinge 2a, column 8, lines 12 through 19), a recording section that records images on a recording medium (process cartridge 40, column 4, line 44 through column 5, line 9), and a reading section that reads images from a document (image reading unit 90, column 4, lines 24 through 37), with the reading section having a front edge substantially in coincidence with the front side of the outer casing, a back edge opposing the front edge, left and right walls, and a lower surface (see Fig. 1), the reading section being disposed above the shaft and pivotable about the shaft (column 8, lines 12 through 19, see Figs. 1 and 2), wherein when the reading section pivots away from the recording section, a space is provided above the recording section (large access section 1a, column 8, lines 16 through 19), and the recording section is exposed outside through the space (column 8, lines 20 through 25), wherein the shaft is located approximately halfway between the front edge and the back edge (see Figs. 1 and 2), and when the reading section pivots away from the recording section (see Fig. 2, arrow D), the front edge moves too apposition below the shaft (see Fig. 2).

Regarding **claim 23**, Tanoue discloses a multi-functional device (column 1, lines 8 through 15) comprising an outer casing having a front side, a rear side opposing the front side, and a lower side (printer body 1, see Figs. 1 and 2), a shaft supported on the outer casing (hinge 2a, column 8, lines 12 through 19), a recording section that records images on a recording medium (process cartridge 40, column 4, line 44 through column 5, line 9), and a reading section that reads images from a document (image reading unit 90, column 4, lines 24 through 37), with the reading section having a front edge substantially in coincidence with the front side of the outer casing, a back edge opposing the front edge, left and right walls, and a lower surface (see



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Fig. 1), the reading section being disposed above the shaft and pivotable about the shaft (column 8, lines 12 through 19, see Figs. 1 and 2), wherein when the reading section pivots away from the recording section (see Fig. 2, arrow D), a space is provided above the recording section (large access section 1a, column 8, lines 16 through 19), and the recording section is exposed outside through the space (column 8, lines 20 through 25), and a document discharge tray (delivery tray 22 and an extension tray 23) pivotally and detachably mounted (see Fig. 2 and column 9, lines 14 through 24) on the reading section (column 5, lines 48 through 67) near the front edge of the reading section (see Figs. 1 and 2) for receiving documents discharged from the reading section (column 5, lines 48 through 67), wherein the document discharge tray is maintained at a predetermined angle with respect to a direction in which the documents are discharged when in use (see Figs. 1 and 4) and is pivotable in a direction opposite the pivoting direction of the reading section (see Fig. 2, wherein the discharge tray can pivot in both directions, as seen in path D), wherein the document discharge tray moves integrally with the pivoting movement of the reading section (see Figs. 1 and 2).

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***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanoue *et al.*

(U.S. Patent Number 5,884,117, cited in the Office action dated 9/9/02) in view of Saito *et al.*

(U.S. Patent Number 5,826,133, cited in the Office action dated 9/9/02).

Regarding **claim 6**, Tanoue discloses the device discussed above in claim 1, and further teaches that the recording section is provided with an ink cartridge that can be upwardly removed from the printer after pivoting the reading section away from the recording section (column 8, lines 12 through 25). However, Tanoue fails to specifically teach if the recording section comprises an ink-jet printer. Saito discloses a device that comprises a reading section (304, column 9, lines 62 through 67) and a recording section (305, column 10, lines 1 through 7) whereby the recording section comprises an ink-jet printer (column 11, lines 45 through 57) provided with an ink cartridge that can be upwardly removed from the ink-jet printer after pivoting a section away from the recording section (column 5, lines 37 through 52). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Saito's teachings in the system of Tanoue. Tanoue's system would easily be modified with the teachings of Saito, as the systems share cumulative features, being additive in nature.

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*Allowable Subject Matter*

9. **Claims 12-20** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J. R. P.

Joseph R. Pokrzywa  
Examiner  
Art Unit 2622

jr  
May 1, 2003

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
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